

REMARKS

Claims 1, 3-11, 13-22, 24-33, 35-44, 46-55, 57-64, 66-76, 78-87, 89-115, 116-119 and 129-131 are pending in this application. By this Amendment, claims 1, 11, 22, 33, 44, 55, 75, 87 and 99 are amended. Claims 87, 89-98 and 116-117 are withdrawn from consideration. No new matter is added. Accordingly, Reconsideration of the application is respectfully requested.

I. Allowable Subject Matter

Applicant gratefully acknowledges that the Office Action indicates that claims 80, 81, 101 and 115 are allowed.

II. Rejection Under 35 U.S.C. §102(b)

The Office Action rejects claims 1, 3-6, 10, 33, 35-38, 43, 44, 46-49, 54, 69, 72, 73, 75, 78, 79, 85, 86, 99, 100, 102, 103, 110, 111, 113, 114, 118 and 129-131 under 35 U.S.C. §102(b) over U.S. Patent No. 3,934,810 to Henning. Applicant respectfully traverses the rejection.

Henning does not teach or suggest a mold including "at least one of said recesses having longitudinal edges having a length on the external surface, the edges comprising portions that are adjacent to a periphery of the mold and spaced apart over at least a part of the length prior to a deformation of the mold, and spaced from an upper end of the recess and from a bottom end of the recess," as recited in independent claims 1, 33, 44, 75 and 99.

A. Henning

The Office Action asserts that Henning discloses, in Figs. 1, 3, 7 and 8, a flexible mold having a side wall provided with recesses in the form of notches 27, 87 facilitating radial deformation of the mold. The Office Action asserts that the notches 27, 87 have longitudinal edges include a length on an external surface. Further, the Office Action asserts

that edge portions, e.g., channels 33, 93, adjacent to a periphery of the mold are spaced apart over at least part of the length prior to any deformation of the mold.

The Office Action also asserts that Henning discloses, in Fig. 1, that the recess/slit 27 includes the channel 33 at a top and bottom of the recess/slit 27. Therefore, the Office Action asserts that bottom portion of the channel 33 represents the edge portion spaced from an upper end of the recess 27. See page 4, and page 10, point 9 of the Office Action.

Notwithstanding these assertions, Henning does not teach or suggest the edges comprising portions that are adjacent to a periphery of the mold and spaced apart over at least a part of the length prior to a deformation of the mold, and spaced from an upper end of the recess and from a bottom end of the recess, as set forth in claims 1, 33, 44, 75 and 99.

Henning discloses, in Fig. 7, a flexible mold 75 including a slit 87 having longitudinal edges with a length located on an external wall surface 86. The slit 87 also includes a rounded channel 93. See Fig. 7. When the mold 75 is at rest longitudinal edges of the slit 87 abut. See Fig. 7. However, edge portions of the rounded channel 93 that open to the external wall surface 86 do not abut. See Fig. 7.

Although the edge portions of the channel 93 do not abut, such non-abutting edge portions of the channel 93 cannot reasonably be considered longitudinal edges. Further, the non-abutting edge portions of the channel 93 located adjacent to a periphery of the mold 75 are not spaced from an upper end of the slit 87 and not spaced from a bottom end of the slit 87. Thus, Henning does not teach or suggest, in Fig. 7, the mold of claims 1, 33, 44, 75 and 99.

Henning also discloses, in Figs. 1-3, a flexible mold 15 including a slit 27 having longitudinal edges with a length located on an external wall surface 26. The slit 27 also includes a rounded channel 33. See Fig. 3. When the mold 15 is at rest, the longitudinal

edges of the slit 27 abut. However, edge portions of the rounded channel 33 that open to the external wall surface 26 do not abut. See Fig. 3.

Although the edge portions of the channel 33 do not abut, such non-abutting edge portions of the channel 33 cannot be reasonably considered as longitudinal edges. Further, the non-abutting edge portions of the channel 33 located adjacent to a periphery of the mold 15 is not both spaced from an upper end of the recess and spaced from a bottom end of the slit 27. Thus, Henning does not teach or suggest, in Fig. 3, the mold of claims 1, 33, 44, 75 and 99.

B. Claim 118

The Office Action admits that Henning does not disclose use of an apparatus for molding polydimethyl siloxane silicone, and asserts that the actual use of such material is directed to intended use of the apparatus. Applicant respectfully disagrees.

Although a material worked upon by an apparatus has no significance in determining patentability of the apparatus, such insignificance does not apply to determining the patentability of product claims. See MPEP 2115. Because a mold material that is physically and chemically compatible with polydimethyl siloxane silicone is a structural feature of the mold, the mold material is not intended use of the apparatus in an apparatus claim directed to the mold. Therefore, a mold material that is physically and chemically compatible with polydimethyl siloxane silicone must be considered in determining patentability of apparatus claim 118 directed to a mold.

The Office Action also alleges that the mold structure of Henning is inherently "made of a material physically and chemically compatible with polydimethyl siloxane silicone," as recited in claim 118. Applicant respectfully disagrees.

MPEP 2112 states the following:

The fact that a certain result characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied prior art.

However, the Office Action fails to provide a basis in fact and/or technical reasoning to support the allegation that mold material "made of a material physically and chemically compatible with polydimethyl siloxane silicone" is an inherent characteristic that necessarily flows from the teachings of Henning. The Office Action merely alleges that Henning discloses that the apparatus is capable of molding hardenable materials. However, molding hardenable materials does not require a mold made of a material physically and chemically compatible with polydimethyl siloxane silicone. Thus, the Office Action fails to support the allegation of inherency.

C. Claims 129-131

The Office Action asserts that Henning discloses that the notches 87 extend substantially over an entire height of the mold 75. See Figs. 7 and 8. However, Henning does not teach or suggest that the notches extend over a whole length of the recess/slit. Further, as discussed above, Henning does not teach or suggest non-abutting edge portions of the channel 93 are longitudinal. Therefore, Henning does not disclose a mold for manufacturing a stick of a cosmetic product including "at least one of said recesses having longitudinal edges having a length on the external surface, the edges comprising portions that extend on the

whole length of the recess adjacent to a periphery of the mold and that are spaced apart," as recited in claim 129.

The Office Action also asserts that Henning teaches that a depth of the notches 27 may decrease on coming towards a bottom end of the mold 15. However, as discussed above, Henning does not teach or suggest non-abutting edge portions of the channel 93 are longitudinal. Therefore, Henning does not disclose a mold for manufacturing a stick of a cosmetic product including "at least one of said recesses having longitudinal edges having a length on the external surface, the edges comprising portions that are adjacent to a periphery of the mold and spaced apart over at least part of the length prior to a deformation of the mold, wherein the recess has a depth and wherein the depth of the recess decreases on coming towards a bottom end of the mold," as recited in claim 130.

As discussed above, the Office Action also asserts Henning discloses edges including portions that are adjacent to a periphery of the mold and are spaced apart over at least a part of the length prior to a deformation of the mold. However, Henning does not teach or suggest non-abutting edge portions of a channel are longitudinal. Further, Henning does not teach or suggest that the non-abutting edge portions of the channel are planar portions. Therefore, Henning does not disclose a mold for manufacturing a stick of a cosmetic product including "at least one of said recesses having longitudinal edges having a length on the external surface, the edges comprising planar portions that are adjacent to a periphery of the mold and are spaced apart over at least a part of the length prior to a deformation of the mold," as recited in independent claim 131.

For at least the reasons discussed above, claims 1, 33, 44, 75, 99 and 129-131 are patentable over Henning. Claims 3-6, 10, 35-38, 43, 46-49, 54, 69, 72, 73, 78, 79, 85, 86, 100, 102, 103, 110, 111, 113, 114 and 118 variously depend from claims 1, 33, 44, 75 and 99, and thus also are patentable for at least the reasons set forth above, as well as for the

additional features they recite. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C §102 are respectfully requested.

III. Rejections Under 35 U.S.C. §103(a)

The Office Action rejects claims 7- 10, 39-42, 50-53, 82-84 and 104-107 under 35 U.S.C. §103(a) over Henning; rejects claims 11, 13-22, 24-32, 55, 57-64, 66-68, 70, 71, 74, 76, 108, 109 and 112 under 35 U.S.C. §103(a) over Henning in view of U.S. Patent No. 3,937,438 to Fox et al. ("Fox"); and rejects claim 119 under 35 U.S.C. §103(a) over Henning in view of U.S. Patent No. 6,197,359 to Llorente Hompanera ("Llorente Hompanera "). Applicant respectfully traverses the rejections.

As discussed above Henning does not teach or suggest a mold including "at least one of said recesses having longitudinal edges having a length on the external surface, the edges comprising portions that are adjacent to a periphery of the mold and spaced apart over at least a part of the length prior to a deformation of the mold, and spaced from an upper end of the recess and from a bottom end of the recess," as recited in independent claims 1, 33, 44, 75 and 99. Independent claims 11, 22 and 55 recites similar features.

The Office Action asserts that Fox and Llorente Hompanera disclose various features recited in the dependent claims. However, neither Fox nor Llorente Hompanera remedies the deficiencies of Henning as discussed above with respect to claims 1, 33, 44, 75 and 99. Therefore, neither Henning, Fox nor Llorente Hompanera, alone or in permissible combination, would have rendered obvious the mold of independent claim 55.

Claims 7- 10, 13-21, 24-32, 39-42, 50-53, 57-68, 70, 71, 74, 76, 82-84, 104-109, 112 and 119 variously depend from 1, 11, 22, 33, 44, 55, 75 and 99, and thus also would not have been rendered obvious by Henning, Fox or Llorente Hompanera, alone or in permissible combination. Accordingly, reconsideration and withdrawal of the rejections are respectfully requested.

IV. Rejoinder

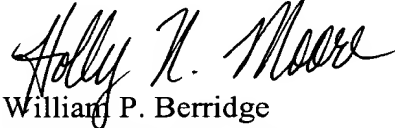
Claim 87 is amended to include all of the features recited in independent claims 1, 11, 22, 33, 44, 55 and 75 in Markush format. Accordingly, upon allowance of the other independent claims, rejoinder and allowance of independent claim 87 and dependent claims 89-98, 116 and 117 is respectfully requested.

V. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 3-11, 13-22, 24-33, 35-44, 46-55, 57-64, 66-76, 78-86, 99-115, 188, 119 and 129-131 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



William P. Berridge
Registration No. 30,024

Holly N. Moore
Registration No. 50,212

WPB:HNM/cfr

Attachments:

Request for Continued Examination
Petition for Extension of Time

Date: August 19, 2005

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

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